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**Filed** : **February 14, 2001**

### **REMARKS**

Claims 1, 6, 9, and 11 are amended and Claims 48-52 are added by this paper. Claims 2-5, 7-8, 10 and 12-47 are unchanged. Claims 1-52 are pending in the application. Reconsideration and allowance of the claims in light of the present remarks is respectfully requested.

#### Examiner Interview

Applicant and Applicant's representative wish to express their appreciation for the availability of Examiner Hwang to conduct an interview on May 1, 2007, to discuss various matters related to the case. Applicant believes that substantial progress was made as a result of the interview, and believes that this reply completely addresses the Examiners' concerns expressed therein.

#### Discussion of the Rejections Under 35 U.S.C. § 101

Claims 1-47 were rejected under 35 U.S.C. § 101 as being directed to non-statutory matter. Applicant has amended Claims 1, 6, 9 and 11 to overcome the rejection as discussed at the personal interview. In certain embodiments, output by the system and method is discussed in the specification at least at page 49, lines 26-27 ("the system returns a report of the diagnostic results"), page 78, lines 11-12 ("output a particular diagnosis"), page 86, line 10 ("visual display"), page 86, line 16 ("telephone"), page 86, lines 23-24 ("other ways") and Figure 35, for example. Although the specification has been referenced for explanatory purposes, it is not intended that the claims shall be limited to specific embodiments provided in the specification.

#### Discussion of the Rejection under 35 U.S.C. § 102(b)

Claims 6-9, 20-27, 29-38 and 40-42 have been rejected under 35 U.S.C. 102(b) as being anticipated by Iliff (U.S. Patent No. 5,868,669).

#### **To Anticipate a Claim, the Reference Must Teach Every Element of the Claim**

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union*

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Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, i.e., identity of terminology is not required. In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

### **Analysis**

The Iliff reference does not teach every element of the independent Claims 6 and 9. Claim 6 recites in pertinent part: "a disease object, a symptom object, a valuator object, a question object, a node object and a candidates object, wherein the objects are arranged in a hierarchical relationship such that the result of one of the objects is input to another of the objects; and at least one of the diagnostic objects directly invokes another of the diagnostic objects". Claim 9 recites in pertinent part: "wherein the diagnostic objects include at least a plurality of disease objects, a plurality of symptom objects and a plurality of valuator objects, and wherein at least some of the diagnostic objects perform their own tasks and directly call upon other diagnostic objects to perform their tasks at the appropriate time".

In contrast, as discussed and agreed to at the interview, the Iliff reference uses traditional procedural diagnostics, and just mentions the possibility of programming in an object oriented language such as C++ . Programming in an object oriented language such as C++ is different than the diagnostic objects recited in Claims 6 and 9. There is no discussion in the Iliff reference of diagnostic objects where at least one of the diagnostic objects directly invokes or calls upon another of the diagnostic objects. Therefore, the Iliff reference cannot be used to anticipate independent Claims 6 and 9.

### Discussion of the Rejections Under 35 U.S.C. § 103(a)

Claims 1, 3-5, 10-13, 15-19 and 43-47 were rejected under 35 U.S.C. § 103(a) as being obvious over Iliff (U.S. Patent No. 5,868,669) in view of Gray (U.S. Patent No. 6,149,585). Claims 2 and 14 were rejected under 35 U.S.C. § 103(a) as being obvious over Iliff in view of Gray and further in view of Branson et al. (U.S. Patent No. 6,598,035). Claims 28 and 39 were rejected under 35 U.S.C. § 103(a) as being obvious over Iliff in view of Branson et al.

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### **Prima Facie Obviousness Requires a Teaching or Suggestion of All Claim Limitations**

M.P.E.P. § 2143.03 recites that all claim limitations must be taught or suggested. To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

### **Analysis**

The cited references do not teach every element of the independent Claims 1 and 11. Claim 1 (and similarly Claim 11) recites in pertinent part: "selecting a disease object applicable to a patient; and invoking a preferred symptom object or one of the related alternative symptom objects for the selected disease object so as to output a diagnosis of a patient based on the object invocation".

In contrast, as discussed and agreed to at the interview, the Iliff reference uses traditional procedural diagnostics, and just mentions the possibility of programming in an object oriented language such as C++ . The specific programming language does not in any way disclose or motivate the objects recited in Claims 1 and 11. There is no discussion in the Iliff reference of objects, much less specific types of objects that could be designed and the way that the objects could interact. I.e., the use of objects requires designing a new software architecture which is not related to the procedural main loop/subroutine architecture disclosed in the Iliff reference.

Furthermore there is no discussion of archived symptom objects in the Iliff reference. Applicant's Claim 1 (and similarly Claim 11) recites "wherein the alternative symptoms for a particular preferred symptom are selected from a set of archived symptom objects that are available for reuse". The Office Action identified Figure 6, col. 13, lines 6-29, and col. 39, lines 36-57 of Iliff as teaching this feature. Figure 6 shows a medical history objects database, which is described in col. 23 as being "a catalog of unique alphanumeric codes, each code corresponding to a medical condition or diagnosis that is not expected to change during the life of the patient (e.g., a diagnosis for asthma is coded as "RWHAST")". The database can also contain clinical sounds or images. The portion of the Iliff reference at col. 13, lines 6-29 describes additional medical codes such E942.1. The portion of the Iliff reference at col. 39,

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lines 36-57 describes examples of diagnostic screening questions for headache. None of these citations describe symptom objects that are invoked so as to output a diagnosis of a patient based on the object invocation, as recited in pertinent part in Claim 1 (and similarly in Claim 11): “invoking a preferred symptom object or one of the related alternative symptom objects for the selected disease object so as to output a diagnosis of a patient based on the object invocation”. Although the specification has been referenced for explanatory purposes, it is not intended that the claims shall be limited to specific embodiments provided in the specification.

#### Dependent Claims

Although Applicant has not addressed all the issues of the dependent claims, Applicant respectfully submits that Applicant does not necessarily agree with the characterization and assessments of the dependent claims made by the Examiner, and Applicant believes that each claim is patentable on its own merits. The dependent claims are dependent either directly or indirectly on one of the above-discussed independent claims. Applicant respectfully submits that pursuant to 35 U.S.C. § 112, ¶4, the dependent claims incorporate by reference all the limitations of the claim to which they refer and include their own patentable features, and are therefore in condition for allowance. Therefore, Applicant respectfully requests the withdrawal of all claim rejections and prompt allowance of the claims.

#### New Claims

Applicant has added new Claims 48-52. New dependent Claims 48-52 are supported at least by pages 12-13 of the specification.

### **CONCLUSION**

In light of the above amendments and remarks, reconsideration and withdrawal of the outstanding rejections are specifically requested. Applicant respectfully submits that the claims of the above-identified application are in condition for allowance. However, if the Examiner finds any impediment to allowing all claims that can be resolved by telephone, the Examiner is respectfully requested to call the undersigned.

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Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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Dated: \_\_\_\_\_

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